

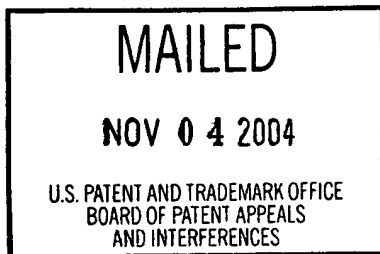
The opinion in support of the decision being entered today
was **not** written for publication in a law journal and
is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIZUHO TADOKORO and KAZUYA TSUKIZAWA



Appeal No. 2004-0545
Application No. 09/510,569

ON BRIEF

Before BARRETT, FLEMING and NAPPI, **Administrative Patent Judges.**
NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of
claims 1 through 8 and 17 through 20, which constitute all the claims remaining
in the application.

Invention

The invention relates to a method to set up the hardware settings in a
data processing system. A data processing system requiring the hardware
settings is connected to a server by a network. The server performs a hardware

setup operation and data from the hardware setup is then transferred to the data processing system. See page 5 of appellants' specification.

Claim 1 is representative of the invention and reproduced below:

1. A method for performing a hardware setup operation on a data processing system, said method comprising:
storing a hardware setup program and a plurality of dynamic link modules in a server data processing system;
coupling data processing system to said server data processing system via a data processing system network;
in response to a request to execute said hardware setup program by said data processing system, executing said hardware setup program within said server data processing system;
modifying hardware configuration data within said data processing system according to instructions generated from said execution of said hardware setup program within said server data processing system; and
de-coupling said data processing system from said server data processing system after a completion of said hardware setup operation.

References

The reference relied upon by the examiner is:

Rakavy et al. (Rakavy)	6,324,644	Nov. 27, 2001 (filed Jan 19, 1999)
------------------------	-----------	---------------------------------------

Rejection at Issue

Claims 1 through 8 and 17 through 20 stand rejected under 35 U.S.C. § 102 as being anticipated by Rakavy. Throughout the opinion we make reference to the Briefs¹ and the answer for the respective details thereof.

¹Appellants filed an Appeal Brief on June 12, 2003 (certified as being mailed on June 10, 2003, in accordance with 37 C.F.R. § 1.8(a)) and appellants filed a Reply Brief on August 14, 2003 (certified as mailed on August 11, 2003, in accordance with 37 C.F.R. § 1.8(a)).

Opinion

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 8 and 17 through 20 under 35 U.S.C. § 102. However in accordance with 37 CFR § 41.50(b), we enter a new grounds of rejection against claims 1 through 8 and 17 through 20, under 35 U.S.C. § 112.

Appellants argue on page 5 of the brief that "Rakavy does not teach or suggest the hardware setup program and the dynamic link modules are stored in a server data processing system (which seems to be management workstation 200 in Figure 1 of *Rakavy* according [to] the Examiner's characterization)." On page 6 of the brief, appellants argue "there is no basis to the Examiner's assertion that the hardware setup program and dynamic link modules have been stored in workstation 200." Further, on page 2 of the reply brief, appellants argue that:

Claim 1 also recites a step of "modifying hardware configuration data within said data processing system according to instructions generated from said execution of said hardware setup program within said server data processing system. " In other words, instructions are initially generated within the server data processing system via an execution of the above mentioned hardware setup program within the server data processing system, and the instructions generated within the server data processing system are then utilized to modify the hardware configuration data within the data processing system.

In response to these arguments, the examiner states, on page 8 of the answer:

Rakavy patent teaches about a loader service that is used during the setup period. This loader service causes a workstation (200) (server processing system) (Column 10, lines 55-60) to transfer code and data (hardware setup program and dynamic link modules) from its location to a RAM located on a computer (400) (data processing system) (Col. 5, lines 30-60) For this operation to have taken place, it is inherent that the code and data (hardware setup program and dynamic modules) had to be stored in advance on the workstation (server data processing system) for this operation to be possible.

Before we consider the art applied, we must first determine the scope of the claim. The appellants' arguments do not provide any guidance on how the limitations of a "hardware setup program" and "dynamic links" are to be interpreted. Appellants' specification on page 2, identifies that hardware setup is required so that a "data processing system can recognize and drive" a device, where devices include among other things, a display. Further, on page 9 of appellants' specification, dynamic links are described as including functions and subroutines that are used by the hardware setup program.

We agree with the examiner's analogy of the loader to the claimed hardware setup program. We find that Rakavy teaches an embodiment where a

computer loads from a remote server, a portion of the BIOS. The portion of the BIOS downloaded from the server to the computer is the POST code. See column 18, lines 10-25. Rakavy also teaches that the POST code is used to “initialize the standard system components” including video hardware. See column 2, lines 12 through 16. We consider those portions of the POST code as meeting the claimed dynamic links. We consider the act of transmitting the post code from the server to the computer as meeting the claimed step of modifying hardware configuration data. Further, we find that since the loader program is running on the server and the POST data is downloaded from the server, the data must necessarily be stored on the server. Accordingly, we find that Rakavy teaches the claimed step of storing a hardware setup program and the step of modifying hardware configuration data.

Appellants argue on page 6 of the brief that:

After the hardware setup operation has been completed, the data processing system is physically de-coupled to the server data processing system. Hence, Claim 1 (and similarly claims 5 and 17) recites a step of “de-coupling said data processing system from said server data processing system after a completion of said hardware setup operation” (lines 13-14). Even though the word “physically” was not explicitly recited in Claims 1, 7, and 17, the data processing system cannot be coupled to the server data processing system via any software means without first being physically coupled to the server data processing system; hence the word “physically” is implied. (emphasis original)

Further on page 3 of the reply brief, appellants argue:

The term “coupling” generally means being joined together, and the term “de-coupling” generally means being separated apart. In the context of claim 1, the recited step of “de-coupling said data processing system from said server data processing system” means that the data processing system is being separated apart from the server data processing system.

The examiner responds to these arguments on page 9 of the answer, arguing that Rakavy teaches an electronic connection between the computer and server. The examiner states:

The act of passing control to the CPU 110, shows that the computer (400) is able to operate on its own and no longer need to be electronically connected with the remote workstation (200) as indicated by the network enhanced BIOS ceasing to function (Col 11, lines 20-30). By ceasing to function, computer (400) is disconnected electronically from the workstation (200) which means that it is decoupled from the network.

Further, the examiner argues that the appellants' arguments directed to "physically" connecting and disconnecting, are not considered, as the claim does not contain such a limitation.

We concur with the examiner that Rakavy teaches coupling between the computer and the server, and that the claim is not limited to physically coupling and decoupling the computer to the server. However, we disagree with the examiner that the act of passing control to the CPU meets the claimed step of decoupling. We find that the plain meaning of the claim limitation of decoupling, as argued by appellants, is "the data processing system is separated apart from the server."² However, we do not construe the limitation as narrowly to only include physical separation, but rather to be broad enough to include electrical separation. Thus, we do not find that Rakavy teaches the claim step of

² We note, for the reasons stated *infra*, appellants' specification provides no assistance in interpreting this limitation as it is devoid of any disclosure related to decoupling.

decoupling as claimed in independent claim 1, 5 and 17.³ Accordingly we will not sustain the examiner's rejection of claims 1 through 8 and 17 through 20 under 35 U.S.C. § 102.

New grounds of rejection under accordance with 37 CFR § 41.50(b).

We find that appellants specification, as originally filed does not provide support for the limitation of "decoupling said data processing system from said server data processing system after a completion of a hardware setup operation" as is claimed in each of independent claim 1, 5 and 17. Thus, we now reject claims 1 through 8 and 17 through 20 under 35 U.S.C. § 112, first paragraph.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention."

³ We note the issue of whether the decoupling may be obvious in light of a secondary reference is not before us.

Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

Appellants' originally filed specification, on pages 9 through 10 and 14 through 15, describe an operation whereby the data processing system accesses a server data processing system through a network. We consider these sections of the specification to provide support for the claim limitation of coupling the data processing system and the server data processing system. However, we see no support for the decoupling the data processing system from the server data processing system upon completion of the hardware setup program.

The operation of the hardware setup program is depicted in the flowcharts of appellants' figures 4 and 5 and described on pages 15 through 17 of appellants' originally filed specification. The final step in the flow chart of figure 4, step S44, is described, on page 15 of appellants' originally filed application, as "[t]he small program 34 executes the hardware setup program 31 on the memory of the client data processing system 23, while storing the program itself on the server data processing system 22 (stepS44)." The final steps in the hardware setup flow chart of figure 5, steps S53 and S55, are described on page

16 of appellants' originally filed application, as "transfers control to the OS 25 of the client data processing system 23." We do not find that one of ordinary skill in the art would recognize these steps as including, or necessarily anteceded by a step of, decoupling the data processing system from the server data processing. As stated *supra* we find that the scope of the decoupling limitation is "the data processing system is separated apart from the server." Accordingly, we now enter a rejection of independent claims 1, 5, and 17 under the written description requirement of 35 U.S.C. § 112, first paragraph.

Conclusion

We will not sustain the examiner's rejection of claims 1 through 8 and 17 through 20 under 35 U.S.C. § 102 as being unpatentable over Rakavy.

In accordance with 37 CFR § 41.50(b), we have entered a new rejection of claims 1 through 8 and 17 through 20 under 35 U.S.C. § 112, first paragraph

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

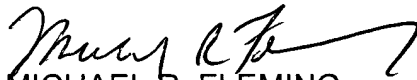
(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

Reversed
37 CFR § 41.50(b)



LEE E. BARRETT
Administrative Patent Judge



MICHAEL R. FLEMING
Administrative Patent Judge



ROBERT E. NAPPI
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)
)
)

REN/vsh

Appeal No. 2004-0545
Application No. 09/510,569

IBM Corporation
P O Box 12195
Dept 9CCA, Building 002
Research Triangle Park, NC 27709